

REMARKS / ARGUMENTS

Applicant thanks the Examiner for the Office Action mailed on February 9, 2006. After entry of this Amendment, claims 1, 2, 7, and 10-20 are pending. Claims 3-6 and 8-9 have been canceled. The Applicant respectfully requests the Examiner's consideration of these remarks in light of the amendments and new claims.

In the Office Action of February 9, 2006, the Examiner first rejected claim 1 under 35 U.S.C. § 102(b) as being anticipated by Jones, United States Patent No. 6,019,224. The Examiner asserted that Jones discloses a protective liner that is capable of being used in a storage area of a vehicle, comprising a floor 22, substantially normal walls 16, a sleeve 20, and a resilient frame 21 made from a flexible, substantially impermeable material.

In response, the Applicant has amended claim 1 to recite "a flexible and substantially impermeable wall affixed to said sleeve wherein the wall is normal to the plane formed by the floor." The Applicant submits that Jones does not anticipate this limitation of claim 1. The Applicant therefore respectfully requests that the Examiner withdraw this rejection against claim 1.

The Examiner next rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of Cesare, United States Patent No. 6,105,842. The Examiner contends that Jones discloses the protective liner but does not teach that it is the shape and size of a cargo compartment of a motor vehicle. The Examiner further contends that Cesare discloses a protective liner in the shape of a pickup truck bed to allow use of the bed for storing possessions. The Examiner also asserts that Cesare discloses that the liner maintains its shape when standing alone but does not disclose how this is done. Finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a protective liner in the shape of a pickup truck bed as disclosed by Cesare with the protective liner

disclosed by Jones to provide a liner that makes efficient use of the space in the pick-up truck bed and has the means for maintaining its shape.

The Applicant has previously objected to the combination of Jones and Cesare on the basis that Jones is non-analogous art and that the Examiner has shown no suggestion to combine these references. The Applicant appreciates the Examiner's substantive responses to these arguments; however, the Applicant believes that the Examiner's conclusions on these points is incorrect.

Turning first to the question of whether Jones is non-analogous art, the Applicant directs the Examiner to the case In re Clay, 966 F.2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992). In that case, the Federal Circuit stated that a prior art reference can be found analogous in one of two ways. First, it is analogous if it is from the same field of endeavor as the Applicant's invention. Alternatively, if it is not within the Applicant's field of endeavor, the reference may be found analogous if the reference is reasonably pertinent to the particular problem with which the inventor is involved. *Id.*, 23 USPQ2d at 1060. *See also In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). In the case of the Jones reference, the Applicant contends that it is not from the Applicant's field of endeavor, which may be characterized from the preamble of the claims, namely, protective liners for vehicle storage areas. Turning then to the second prong in the analysis, the Federal Circuit stated the following:

A reference is reasonably pertinent if even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem . . . If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection . . . If it is directed to a different purpose, the inventor would, accordingly, have had less motivation or occasion to consider it.

Clay, 23 USPQ2d at 1061. The purpose of the Applicant's instant invention is evident from the Applicant's disclosure in the section of the specification entitled "Summary of the Invention."

There, the Applicant notes repeatedly that the object of the present invention is to provide a new and

improved cargo liner for motor vehicles. In contrast, it is apparent from the Jones reference that it is directed to providing a temporary water dish for pets (Col. 1, line 1 - Col. 4, line 30). Respectfully, the Examiner's assertion that "Jones . . . is capable of being used in a vehicle storage area" is not relevant to the analysis. The question is whether Jones is directed to the purpose of the instant invention, and it is evident from the Jones disclosure that it is not. For this reason, the Applicant renews his argument that Jones is non-analogous art, and therefore is not properly combined with Cesare in rejecting claim 2 under 35 U.S.C. § 103. The Applicant therefore respectfully requests that the Examiner withdraw this rejection against claim 2.

The second basis on which the Applicant believes that the Jones-Cesare combination is improper is the lack of suggestion to combine these references. As the Federal Circuit stated in Oetiker, "there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the Applicant's invention itself." In re Oetiker, 24 USPQ2d at 1446. The Federal Circuit has expanded on this elsewhere. Specifically, the suggestion to combine the references need not be present in the specific references themselves but may be part of the "knowledge generally available to one of ordinary skill in the art." In re Fine, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1998). "Obviousness is tested by what the combined teachings of the references would have suggested to those of ordinary skill in the art . . . But it cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination . . . And teachings of references can be combined *only* if there is some suggestion or incentive to do so." *Id.* at 1599 (internal quotes and citations omitted).

In responding to the Applicant's previous argument on this point, the Examiner stated that "in this case, combination of Cesare with Jones would be obvious to one of ordinary skill in the art to make the most efficient use of the space in a vehicle storage area." This is merely a conclusory statement. It does not objectively identify where the suggestion to combine these references comes

from. The Applicant submits that there is no suggestion found within either Cesare or Jones to combine them as the Examiner suggests. Further, the Examiner has provided no evidence that the suggestion to combine Cesare with Jones was in the knowledge generally available to one of ordinary skill in the art at the time the instant invention was made. Lacking this suggestion, the Applicant respectfully submits that the Examiner's rejection on this basis is improper. Consequently, the Applicant respectfully requests that the Examiner withdraw this rejection against claim 2.

Moving on, the Examiner next rejected claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of Behlman, United States Patent No. 5,215,205. The Examiner asserted that Jones discloses the protective liner as discussed above but does not teach that the liner is removably secured to the storage area. The Examiner further asserted that Behlman discloses a protective liner for use in the cargo area by the use of a hook and loop type gripper 43. The Examiner also asserted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a hook and loop type gripper as disclosed by Behlman with the protective liner disclosed by Jones to allow securing of the liner in position of the cargo area.

In response to this rejection, the Applicant directs the Examiner to the argument above regarding the Jones reference being non-analogous art. Further, as with the combination of Jones and Cesare, the Applicant believes that the proposed combination of Jones and Behlman is also improper for a lack of a suggestion to combine these references. In responding to this argument, the Examiner stated that "it certainly would be obvious to one of ordinary skill in the art to incorporate the fastening concept from one storage area liner and another liner to address the need for securement." Again, this is a conclusory statement that does not identify where in the prior art the suggestion to combine Jones and Behlman exists. Absent evidence of this suggestion, this rejection is improper. For these reasons, the Applicant respectfully requests that the Examiner withdraw this rejection against claim 7.

The Examiner next rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Jones and Behlman as applied to claim 7 and further in view of Cesare. The Examiner also rejected claims 14-16 as being unpatentable over Jones and Behlman as applied to claim 7 and further in view of Dearborn, IV, United States Patent No. 5,366,124 (hereinafter referred to as “Dearborn”). The Applicant believes that these rejections are improper for the same reasons that the Examiner’s rejection of claim 7 is improper. Namely, Jones is a non-analogous art reference, and the Examiner has shown no evidence of a suggestion to combine Jones and Behlman. For these reasons, the Applicant respectfully requests that the Examiner withdraw the rejections of claims 13-16 based upon the improper combination of Jones and Behlman.

The Examiner next rejected claims 1, 2, 7, and 13 under 35 U.S.C. § 103(a) as being unpatentable over Cesare in view of Zheng, United States Patent No. 6,360,761. Regarding claims 1 and 2, the Examiner contends that Cesare discloses a protective liner in the shape of a pickup truck bed comprising a floor 4 and substantially normal walls 48, 50, 52, 54 made from a flexible, substantially impermeable material. The Examiner further contends that Cesare discloses that the liner maintains its shape when standing alone but does not teach the use of a sleeve with a coilable resilient frame. Regarding Zheng, the Examiner contends that Zheng discloses a collapsible structure capable of use as a liner with a floor (base) having a coilable resilient frame in a sleeve affixed to the perimeter of the floor to maintain the shape of the structure when standing and allow the structure to be collapsed for storage. The Examiner also contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a coilable resilient frame in a sleeve affixed to the perimeter of a floor as disclosed by Zheng in the liner disclosed by Cesare to provide means for the liner to maintain its shape when standing and to be collapsed for storage. Regarding claims 7 and 13, the Examiner asserts that Cesare discloses that the liner can be removably secured to the vehicle by use of grommets 20 with rope or bungee cords.

As with Jones, the Applicant believes that Zheng is also a non-analogous art reference. Zheng is not within the Applicant's field of endeavor, nor is it addressed to the same purpose. Whereas the instant invention is drawn to protective liners for vehicle storage areas, the Zheng reference is addressed to collapsible structures used primarily as play structures for children (Col. 1, line 30 - Col. 2, line 8). Zheng is therefore non-analogous to the Applicant's field of endeavor. In addition, the Examiner has provided no evidence from the prior art demonstrating a suggestion to combine the Zheng and Cesare references. For these reasons, the Applicant believes that the Examiner's rejection of claims 1, 2, 7, and 13 based upon a combination of these references is improper and should be withdrawn.

The Examiner next rejected claims 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Cesare and Zheng, as applied to claim 7, and further in view of Dearborn. The Examiner contends that the protective liner of claim 7 having an uncollapsed and collapsed orientation is disclosed except for the use of a container for the collapsed liner and that Dearborn discloses a collapsible protective liner with a container for storage and transportation of the liner 50 with a drawstring closure and a carrying strap formed by the end of the drawstring. The Examiner also contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a container for the liner with a closure and a carrying strap as disclosed by Dearborn with the liner disclosed by Cesare and Zheng to provide for easy storage and handling of the collapsed liner.

In response to this rejection, the Applicant directs the Examiner's attention to his response above rebutting the Examiner's rejection of claim 7 in light of the Cesare and Zheng references. The arguments presented there apply with equal force in the context of this rejection, and the Applicant therefore respectfully requests that the Examiner withdraw this rejection as well.

The Examiner next rejected claims 10-12 under 35 U.S.C. § 103(a) as being unpatentable over Jones, or Cesare and Zheng, in view of Dearborn. The Examiner contends that Jones, or Cesare

and Zheng disclose the protective liner of claim 1 having an uncollapsed and collapsed orientation but do not teach use of a container for the collapsed liner. The Examiner contends that Dearborn discloses a collapsible protective liner with a container for storage and transportation of the liner 50 with a drawstring closure and a carrying strap formed by the end of the drawstring. The Examiner further contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of a container for the liner with a closure and a carrying strap as disclosed by Dearborn with the liner disclosed by Jones or Cesare and Zheng to provide for easy storage and handling of the collapsed liner.

In response, the Applicant directs the Examiner's attention to arguments above addressed to Jones and Zheng being non-analogous art references, as well as the impropriety of combining the Cesare and Zheng references. In addition, the Applicant submits that the Examiner has failed to show any suggestion in the prior art to combine the Jones and Dearborn references or the Cesare and Zheng combination with Dearborn. Absent some suggestion in the prior art to make either of these combinations in these ways, the Applicant believes that these rejections are improper and should be withdrawn.

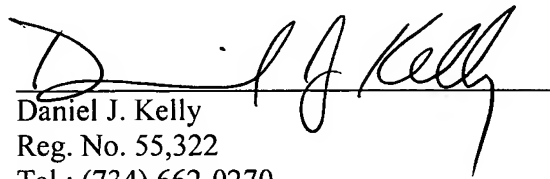
The Examiner next rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Jones in view of Cesare, Dearborn, and Lester, et al., United States Patent No. 6,905,162. The Examiner also rejected claim 17 under 35 U.S.C. § 103(a) as being unpatentable over Cesare in view of Zheng, Dearborn, and Lester, et al. Each of these rejections proposes combining Cesare with either Jones or Zheng, either of which combination the Applicant has already shown to be improper on multiple bases. In addition, the Examiner has demonstrated no suggestion in the prior art to combine either of these combinations with the Dearborn and Lester, et al. references. For this reason as well, these rejections are also improper. The Applicant respectfully requests that the Examiner therefore withdraw these rejections of claim 17.

In addition to the above matters, the Applicant has added new claims 18-20 and respectfully requests the Examiner's consideration of the same.

The Applicant thanks the Examiner for his consideration of the above remarks in light of the new and amended claims. If the Examiner should have any questions regarding this paper, he may contact Applicant's undersigned Attorney at (734) 662-0270.

Respectfully submitted,

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